

REMARKS

The above-referenced application has been reviewed in light of the Examiner's Office Action dated November 21, 2003. Claims 1-7, 12, 14, 16, and 17 have been amended, and a new Claim 18 has been added. Accordingly, Claims 1-18 are currently pending in this application. No new matter has been added. The Examiner's reconsideration of the rejections in view of the above amendments and the following remarks is respectfully requested.

In accordance with the Office Action, Figures 6 and 7 have received objections for consistency with the specification. Accordingly, proposed drawing corrections have been indicated in red ink on the proposed substitute drawing sheets of Figures 6 and 7, which are included in Appendix A.

In accordance with the Office Action, the specification has received an objection for consistency with Figure 6. The specification has been amended. This objection is further addressed by the above-mentioned correction to Figure 6.

In accordance with the Office Action, Claims 1-12, 14, 16 and 17 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

Claims 1-7, 12, 14, 16 and 17 have been amended to more clearly recite the subject matter that Applicant regards as the invention, or to overcome informalities. These changes are supported by the application as originally filed, and no new matter has been added. Accordingly, it is respectfully submitted that amended Claims 1-7, 12,

14, 16 and 17, and those that depend therefrom, are not indefinite per 35 U.S.C. §112, second paragraph.

In accordance with the Office Action, Claims 1-4, 9, 11-13, 15 and 16 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,779,273 to Beucler et al. (the '273 patent) in view of U.S. Patent No. 6,516,432 B1 to Motika et al. (the '432 patent). Applicants' respectfully submit with traverse that amended Claims 1 and 12 are not rendered obvious by the '273 patent in view of the '432 patent for at least the reasons set forth below.

The '432 patent was owned by or subject to an obligation of assignment to International Business Machines Corporation at the time the subject matter of the current application was made. The subject matter of the current application was also owned by or subject to an obligation of assignment to International Business Machines Corporation when it was made. Therefore the '432 is removed as a reference pursuant to 35 U.S.C. §103(c). Thus amended Claims 1 and 12 cannot be rendered obvious by the '273 patent in view of the '432 patent.

Likewise, amended Claims 2, 3, 4, and 16, and Claims 9, 11, 13, and 15 each depend from one of amended independent Claims 1 or 12, and are not rendered obvious for at least the same reasons.

In accordance with the Office Action, Claims 7, 8 and 10 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,779,273 to Beucler et al. in view of U.S. Patent No. 6,516,432 B1 to Motika et al. as applied to amended Claim 1, and further in view of Nakao et al. (US-2002/0073373 A1). Applicants' respectfully

submit with traverse that Claims 7, 8 and 10 are not rendered obvious by Beucier et al. in view of Motika et al. as applied to amended Claim 1, and further in view of Nakao et al., for at least the reasons set forth below.

As discussed above Motika et al. is removed as a reference and cannot be used to render amended Claim 1 obvious. Claims 7, 8, and 10 depend from amended Claim 1, and necessarily include each of the elements and limitations thereof. Nakao et al. does not cure the deficiencies of Beucier et al., and thus fails to render obvious amended Claims 7, 8, and 10.

In accordance with the Office Action, Claims 5, 6 and 17 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,779,273 to Beucier et al. in view of U.S. Patent No. 6,516,432 B1 to Motika et al. as applied to Claims 2 and 12, and further in view of Koprowski (US-6,021,514). Applicants' respectfully submit with traverse that Claims 5, 6 and 17 are not rendered obvious by Beucier et al. in view of Motika et al. as applied to amended Claims 1 and 12, and further in view of Koprowski, for at least the reasons set forth below.

As discussed above, Motika et al. is removed as a reference and cannot be used to render amended Claims 1 and 12 obvious. Amended Claim 2 depends from Claim 1, and both Claim 5 and amended Claim 6 depend from amended Claim 2, and thus necessarily include each of the elements and limitations thereof. Likewise, amended Claim 17 depends from amended Claim 12, and necessarily includes each of the elements and limitations thereof. Koprowski does not cure the deficiencies of Beucier et al., and thus fails to render obvious Claim 5, and amended Claims 6 and 17.

In accordance with the Office Action, Claim 14 stands rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,779,273 to Beuclet et al. in view of U.S. Patent No. 6,516,432 B1 to Motika et al., and further in view of Kim (US-5,574,733). Applicants respectfully submit with traverse that amended Claim 14 is not rendered obvious by Beuclet et al. in view of Motika et al., and further in view of Kim, for at least the reasons set forth below.

As discussed above, Motika is removed as a reference and cannot be used to render amended Claim 12 obvious. Amended Claim 14 depends from amended Claim 12, and necessarily includes each of the elements and limitations thereof. Kim does not cure the deficiencies of Beuclet, and thus fails to render obvious Claim 14.


In column 2, lines 6-12, Beuclet recites, "Other methods involve the use of external intelligence to generate data patterns and input them to the array under test, and the use of other external intelligence to receive and analyze the outputs. Such methods may be effective, but one of their drawbacks is that they are time-consuming. And the required external intelligence takes them out of the self-test category anyway." This recital teaches away from the subject matter of the current application, and thus, one of ordinary skill in the pertinent art would not be motivated to combine the teachings of Beuclet et al. with the teachings of Motika et al., and even if they did, would not arrive at Applicants' presently claimed invention.

Therefore, each of the claims 1-17 are neither anticipated nor rendered obvious by the '273 patent to Beuclet et al., per se., or in combination with any of the other references of record in this case.

Conclusion

Accordingly, it is respectfully submitted that amended independent Claims 1 and 12 and new Claim 18 are in condition for allowance for at least the reasons stated above. Since Claims 2-11, and 13-17, each depend from one of the above claims and necessarily include each of the elements and limitations thereof, it is respectfully submitted that these claims are also in condition for allowance for at least the reasons stated. Thus, each of Claims 1-18 is in condition for allowance. All issues raised by the Examiner having been addressed, reconsideration of the rejections and an early and favorable allowance of this case is earnestly solicited.

Respectfully submitted,

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Appendix A

Proposed Drawing Corrections:



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Y029-2001-0127US1 (8728-495)

60

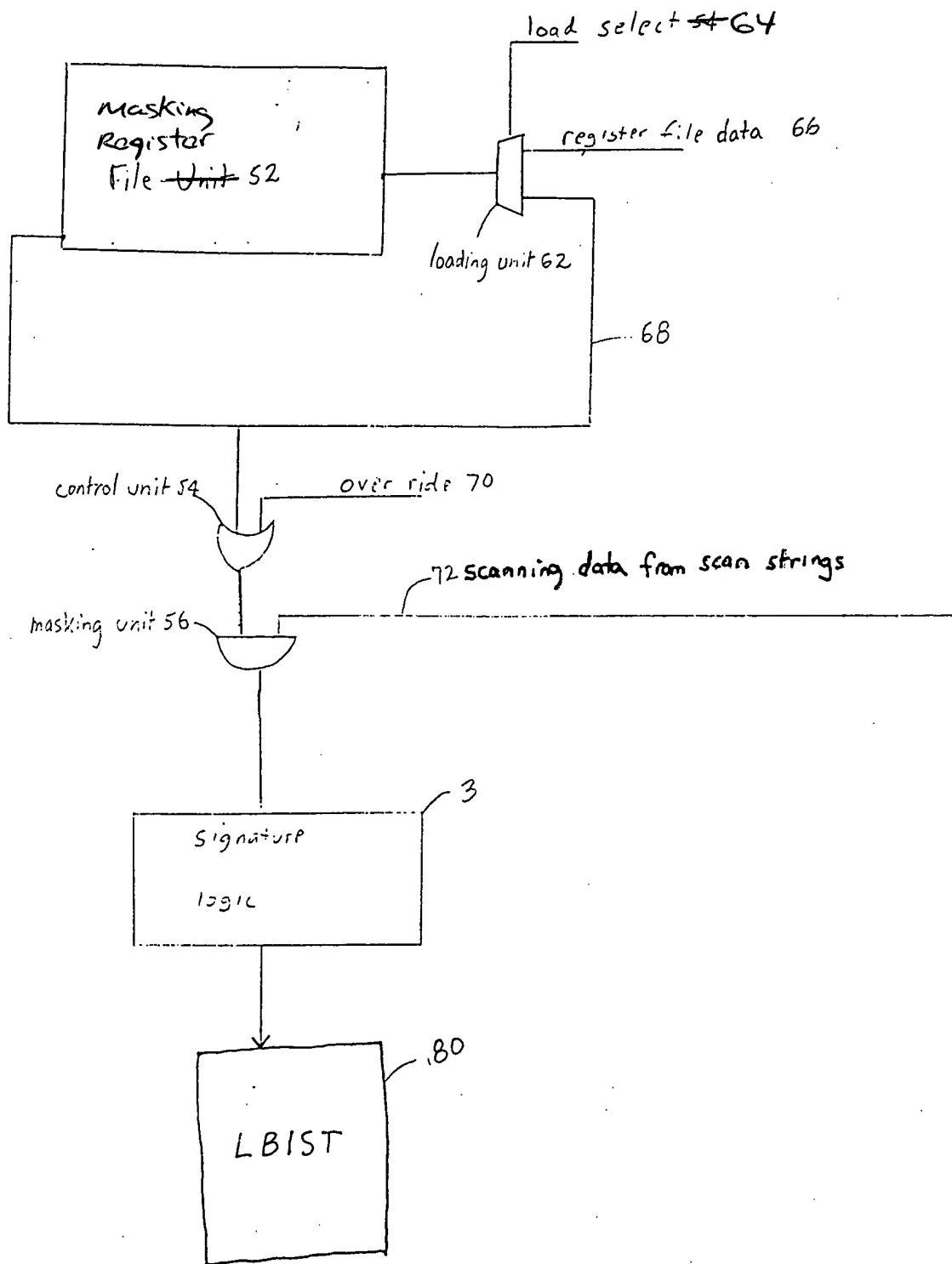


FIG 6



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YOR9-2001-0127451 (8728-495)

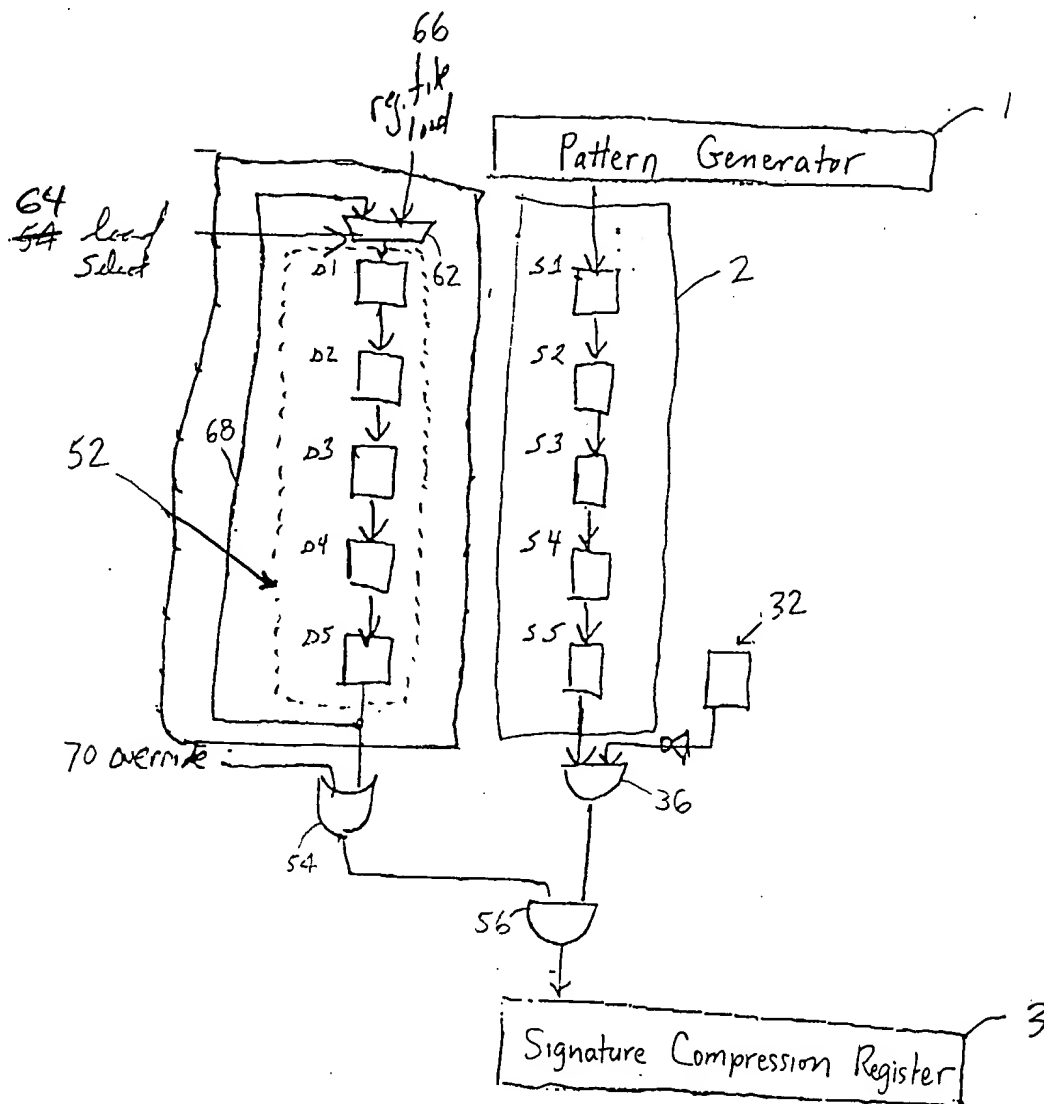


FIG. 7